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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/745,464      | 12/26/2000  | Takeo Katsuda        | 018656-194          | 3991             |

21839 7590 12/29/2005

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ALEXANDRIA, VA 22313-1404

EXAMINER

BRINICH, STEPHEN M

| ART UNIT | PAPER NUMBER |
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2624

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/745,464

Applicant(s)

KATSUDA, TAKEO

Examiner

Stephen M. Brinich

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-4 & 6-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Shen.

Re claims 1-3, 11, & 13-14, Shen discloses (Figures 5 & 8; column 4, line 45 - column 6, line 2) a secure printer in which an image and an associated password are generated, and an authorized recipient is designated by an e-mail address. The image data and password are transmitted to the recipient electronic mailbox over a network by e-mail (Figure 5, step S506) and further transmitted to a selected destination printer (Figure 8, step S805; column 5, line 23). The selected destination printer prints out the image data if (and only if) the printout is certified by entering the matching password into the printer (Figure 8, steps S809-S811; column 7, lines 19-31).

Re claim 2, Shen further discloses (Figure 1, item 10) a scanner for inputting the original image data, but does not disclose that this scanner receives a printer and recipient designation and transmits data to the recipient by e-mail. The latter functions are performed by the computer (1), or more specifically by its CPU (15) (column 5, lines 45-49). Thus, the

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aggregate of the scanner (10) and computer (1) of Shen is readable upon the "scanner" recited in claim 2.

Re claims 3, 9, & 11-12, Shen discloses the transmission of the image data and password are transmitted to two devices (the electronic mailbox and the printer). The transmission of both data items to both devices is readable upon the claim language reciting that one is transmitted to one device and the other is transmitted to another device, in the absence of a specific statement that each data element is transmitted *only* to one or the other.

Re claims 4 & 6, Shen further discloses that the password is requested prior to printing (Figure 8, step S811; column 7, lines 26-31) and prior to transmission (Figure 5, step S504; column 7, lines 20-27).

Re claims 7 & 8, Shen further discloses (Figure 5, step S504; column 7, lines 20-27) that the e-mail address (which inherently designates a message recipient) is entered.

Re claim 9, Shen further discloses (Figure 1, item 10) a scanner for reading image data.

Re claim 10, Shen further discloses (column 5, lines 64-65) the storage of the received image data in an electronic mail box.

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Re claim 12, Shen further discloses (Figure 1) that the printing and networking operations are computer-based (which inherently requires the computer to be executing instruction derived from a computer readable medium).

Re claim 15, Shen discloses (Figure 1) the use of a computer (1) at a user station connected to the Internet (12). The computer of the document-receiving user station would read on the recited "first computer"; the computer of the document-sending user station would read on the recited "second computer"; and the password would read on the recited "certification information".

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shen in view of Yacoub.

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Re claim 5, Shen does not disclose the generation and receipt of completion notification in response to password entry and image formation (i.e. printout).

The generation of a message indicating the completion of printing inherently constitutes a completion notification in response to image formation. Insofar as correct password entry is a prerequisite for image formation in the secure printout system of Shen, such a "Print Complete" message is also inherently in response to correct password entry. Thus, a display which notifies the user of the completion of a print job upon receipt of a print-complete signal transmitted from the printer control to the display) reads on the recited "receiving unit".

Shen does not expressly disclose the generation and display of such a "Print Complete" message. The generation, transmission, and display of a message indicating the completion of printing is well known in the art as disclosed for example by Yacoub (column 9, lines 32-41).

Shen and Yacoub are combinable because they are from the field of printers.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to generate, transmit, and display a "Print Complete" message for the Shen printer.

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The suggestion/motivation for doing so would have been to notify a user that a printout was ready for pickup.

Therefore, it would have been obvious to combine Shen with Yacoub to obtain the invention as specified in claim 5.

***Response to Arguments***

5. Applicant's arguments filed 9/27/05 have been fully considered but they are not persuasive.

Re claims 1-3 & 9-15, Applicant argues (9/27/05 Remarks: page 8, line 12 - page 9, line 23) that Shen does not disclose the claimed subject matter of transmitting image data and password to a designated printer and transmitting the password to a designated recipient by e-mail. In particular, Applicant argues (9/27/05 Remarks: page 9, line 12 - page 10, line 17) that Shen does not disclose transmitting image data in the absence of e-mail.

However, the present claim language does not appear to rule out the case in which both "transmitting the image data and the password to the designated printer" and "transmitting the password to the designated addressee by an E-mail" (as recited in claim 1; the language of claim 2 differs only in referring to the image data as "read image data" and using the term "electronic mail" instead of "E-mail") are read upon a single combined transmission in which the image data and the password

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are present in an e-mail that is sent to the designated printer using the e-mail address of a designated addressee. In particular, the present claim language does not require that the image data is transmitted to the printer in the absence of e-mail.

Re claim 5, Applicant argues ((9/27/05 Remarks: page 10, lines 18-21) that this claim is allowable for the same reasons as parent claim 1.

Applicant's arguments re claim 1 have been addressed above.

#### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated



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from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning the contents of this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 571-272-7430.

Any inquiry relating to the status of this application or proceeding or any inquiry of a general nature concerning application processing should be directed to the Tech Center 2600 Customer Service center at 571-272-2600 or to the USPTO Contact Center at 800-786-9199 or 703-308-4357.

The examiner can normally be reached on weekdays 7:00-4:30, alternate Fridays off.

If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor David Moore can be contacted at 571-272-7437.

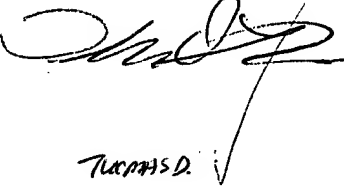
Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 571-273-8300 (as of July 15, 2005).

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Hand-carried correspondence may be delivered to the Customer Service Window, located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

Stephen M Brinich  
Examiner  
Art Unit 2624

smb   
December 21, 2005

  
THOMAS D. ✓



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